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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,185	02/25/2002	Thomas Dag Horn	023533-0144	4869
7590	11/14/2005		EXAMINER	
HUGH MCTAVISH MCTAVISH PATENT FIRM 429 BIRCHWOOD COURTS BIRCHWOOD, MN 55110			ART UNIT	PAPER NUMBER

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliant Appeal Brief  
(37 CFR 41.37)**

Application No.

10/081,185

Applicant(s)

HORN ET AL.

Examiner

Gary B. Nickol Ph.D.

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

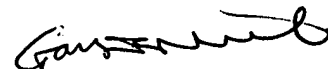
The Appeal Brief filed on 26 August 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Attachment.



**GARY B. NICKOL, PH.D.  
PRIMARY EXAMINER**

Gary B. Nickol Ph.D.  
Primary Examiner  
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Re: Horn *et al.*

***Notice of Defective Appeal Brief***

The rules of practice before the Board of Patents Appeals and Interferences were changed (see: <http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>) effective September 13, 2004.

**The Appeal Brief filed 08-26-2005 is defective for the following reasons:**

On page 1 of Appellant's Brief on appeal, appellants note that the Brief is being submitted in triplicate as set forth in 37 C.F.R. 1.192(a). However, only one copy of the brief rather than three copies is consistent with the Office's move to an electronic file wrapper.

Either the statement regarding the "Status of Amendments" on page 4 of Appellant's Brief or the appendix of the claims is incorrect. In particular, it is noted that the status of Claims 48-51 are denoted as "New"; however, Appellant's state (Brief, page 4) that the claims have not been amended since the final rejection.

Item 5 on page 3 of Appellant's Brief is improperly titled. The "Summary of claimed subject matter" replaced the "summary of the invention".

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Item 6, on page 4 of the Brief is improperly titled. “Grounds of rejection to be reviewed on appeal” replaced “Issues presented for Review”.

Item 7, on page 4 of the Brief (Grouping of Claims) is no longer required.

On page 20, Issue D relates to the restriction requirement. This is not an issue that the Board will consider, nor an issue that the Examiner will take upon consideration in the Examiner’s Answer. After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

Although these are only a few of the defects that the Examiner noticed, Appellants should carefully review all of revisions set forth in the new rules. A brief summary of some of these changes is set forth below:

- The brief must contain the following items (§ 41.37(c)):
  1. **Real party in interest** (similar to former § 1.192).
    - A statement identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest.
  2. **Related appeals and interferences** (similar to former § 1.192).
    - Identification of all other prior and pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision.

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3. **Status of claims** (similar to former § 1.192).
  - The status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of the appealed claims.
4. **Status of amendments** (same as former § 1.192).
  - A statement of the status of any amendment filed subsequent to final rejection.
5. **Summary of claimed subject matter** (replacing "summary of invention").
  - A concise explanation of the subject matter defined in **each of the independent claims** involved in the appeal,
    - Must refer to the specification by page and line number, and to the drawing, if any, by reference characters.
  - For each independent claim involved in the appeal and for each dependent claim argued separately,
    - Every means plus function and step plus function must be identified, and
    - The structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.
6. **Grounds of rejection to be reviewed on appeal** (replacing "issues for review" and "grouping of claims").
  - Example: Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X.
7. **Argument** (has been revised).
  - A separate heading is required for each ground of rejection.
  - Any claim(s) argued separately should be placed under a subheading.
  - A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.
  - When multiple claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.
8. **Claims appendix** (similar to former § 1.192).
  - A copy of the claims involved in the appeal.
9. **Evidence appendix** (new)
  - Copies of any evidence entered and relied upon in the appeal.
10. **Related proceedings appendix** (new)

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- Copies of decisions rendered by a court or the Board in any proceeding identified in the related appeals and interferences section.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary B. Nickol Ph.D.  
Primary Examiner  
Art Unit 1642

GBN



**GARY B. NICKOL, PH.D.**  
**PRIMARY EXAMINER**

